



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,990	07/14/2003	Ned Hoffman	8514-110(ST-A35DIV)	8771
7590	09/29/2004		EXAMINER AZARIAN, SEYED H	
Marger Johnson & McCollom, P.C. 1030 S.W. Morrison Street Portland, OR 97205			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/619,990	HOFFMAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Seyed Azarian	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/14/2004</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321<sup>©</sup> may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-3, rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32, of U.S. Patent No. 6,662,166, the parent case of the current application. Each of the limitation set forth in the claims of the instant application is defined in the claims of the patent.

As an example consider claim 1, of current application, compared to claim 1, of U.S. Patent No. 6,662,166 discloses;

a method for tokenless authorization of a financial transactions between a payor and a payee using an electronic identicator, and at least one payor bid biometric sample, said comprising the steps of, (column 18, lines 1-5);

a. a payor registration step, wherein the payor registers with an electronic identifier at least one registration biometric sample and at least one payor account data (column 18, lines 6-9);

b. a transaction formation step, wherein the financial transaction is formed between the payor and the payee, comprising at least one payor bid biometric sample, wherein the bid biometric sample is obtained from the payor's person (column 18, lines 11-14);

c. at least one transmission step, wherein the payor bid biometric sample is electronically forwarded to the electronic identifier (column 18, lines 16-18);

d. an identification step, wherein the electronic identifier compares the payor bid biometric sample with at least one registered biometric sample for accessing the payor's previously registered account data (column 18, lines 19-23);

e. a transaction payment step, wherein payor payee without the payor presenting smart card or magnetic swipe cards (column 18, lines 31-38).

Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the features of the current application are covered in the patented parent application. That is, the parent application has more specific scope for the claim (compared to current application).

The other claims have similar correspondence to the patent application

### **Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371<sup>9</sup> of this title before the invention thereof by the applicant for patent.

4. Claims 1-3, are rejected under 35 U.S.C. 102(e) as being anticipated by Merjanian (U.S. 5,546,471).

Regarding Claim 1, Merjanian disclose a method for tokenless authorization of a financial transaction between a payor and a payee using an electronic identicator and at least one payor bid biometric sample, said method comprising (column 12, lines 20-26, fingerprint data can be used for transaction);

a. a payor registration step, wherein the payor registers with an electronic identicator at least one registration biometric sample and at least one payor account data (column 11, lines 2-14, his or her fingerprint data);

b. a transaction formation step, wherein the financial transaction is formed between the payor and the payee, comprising at least one payor bid biometric sample, wherein the bid biometric sample is obtained from the payor's person (column 12, lines 28-42 transaction matches);

c. at least one transmission step, wherein the payor bid biometric sample is electronically forwarded to the electronic identicator (column 7, lines 45-51, transmitting input data);

d. an identification step, wherein the electronic identicator compares the payor bid biometric sample with at least one registered biometric sample for accessing the payor's previously registered account data (column 12, lines 40-43, transaction matches);

e. a transaction payment step, wherein payor pays payee without the payor presenting smart cards or magnetic swipe cards (column 12, lines 20-26, fingerprint data can be used for transaction).

Regarding Claim 2, Merjanian disclose a voluntary tokenless identification computer system for determining an individual's identity from an examination of at least one bid biometric sample and a bid personal identification code gathered during a bid step, and comparison with previously recorded registration biometric samples and registration personal identification codes gathered during a registration step, said system comprising (see claim1, also column 5, lines 51-63, comparing previously stored data);

- a. at least one computer (Fig. 1, column 4, lines 48-61, a computer or modem);
- b. first gathering means for voluntary input of at least one registration biometric sample and a registration personal identification code from an individual during the registration step (column 11, lines 2-14, his or her fingerprint data);
- c. second gathering means for voluntary input of at least one bid biometric sample and bid personal identification code, from an individual during a bid step (column 12, lines 28-42 fingerprint data to serve as the operator data);
- d. first interconnecting means for interconnecting said first and second gathering means to said computer for transmitting the gathered biometric samples and personal identification codes from said first and second gathering means to said computer (column 5, lines 51-63, comparing previously stored data, also column 9, lines 24-42);

e. means for storing a plurality of registration biometric samples, and means for associating a subset of the stored registration biometric samples with a registration personal identification code (column 5, lines 51-63, storing);

g. means for comparison of a bid biometric sample with the registration biometric samples associated with the registration personal identification code corresponding to the bid personal identification code, for producing an evaluation (column 12, lines 40-43, transaction matches);

h. execution means within said computer for storage of data and processing and execution of commands for producing a determination, and means for output of said evaluation, or determination, from said computer (column 12, lines 27-59, forward the bill to the selected institution).

With regards to claim 3, the argument analogous to those presented for claims above are applicable.

***Other prior art cited***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. patent (5,351,303) to Willmore is cited for inera-red imaging and pattern recognition system.

U.S. patent (5,615,277) to Hoffman cited for tokenless security system for authorizing access to a secured computer system.

U.S. patent (4,837,422) to Dethloff et al cited for multi-user card system.

U.S. patent (5,351,303) to Willmore cited for infra-red imaging and pattern recognition system.

***Contact Information***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seyed Azarian whose telephone number is (703) 306-5907. The examiner can normally be reached on Monday through Thursday from 6:00 a.m. to 7:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta, can be reached at (703) 308-5246. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR. Status information about the PAIR system, see [http:// pair-direct.uspto.gov](http://pair-direct.uspto.gov). Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**BHAVESH M. MEHTA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600**

*Seyed Azarian  
Patent Examiner*